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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,656	07/20/2001	E. Michael Watts	IVT.0075C1US	3237
21906 7590 08/23/2007 TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			EXAMINER VAN HANDEL, MICHAEL P	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/910,656

Applicant(s)

WATTS ET AL.

Examiner

Michael Van Handel

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 10, 12-18, 20-23, 25-27 and 29-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 10, 12-18, 20-23, 25-27, 29-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/22/2007 has been entered.

Response to Amendment

1. This action is responsive to an Amendment filed 5/22/2007. Claims **1-7, 9, 10, 12-18, 20-23, 25-27, 29-40** are pending. Claims **1-5, 12-18, 20, 23, 25-27, 29-32, 39, and 40** are amended. Claims **8, 11, 19, 24, 28** are canceled.

Response to Arguments

1. Applicant's arguments regarding claims **1, 13, 32, and 40**, filed 5/22/2007, have been fully considered, but they are not persuasive.

Regarding claims **1, 13, 32, and 40**, the applicant argues that the cited art nowhere teaches or suggests a set-top system that includes a storage including subsidiary data. The examiner respectfully disagrees. As noted in the Office Action mailed 3/15/2007, Shoff et al. discloses an interactive entertainment system that enables presentation of supplemental interactive content along side traditional broadcast video programs (see Abstract). Each

Art Unit: 2623

subscriber of the interactive entertainment system has a viewer computing unit 24. The viewer computing unit is a set-top box (STB) 26 coupled to a television (TV) 28 (col. 4, l. 22-25).

When a viewer tunes to a particular channel, the STB determines if the program is interactive. If it is, the STB launches an interactive support module (col. 3, l. 14-18). The STB then displays the supplemental content concurrently with the video content program (col. 3, l. 45-47). Shoff et al. further discloses that the STB may include one or more storage drives, such as a CD-ROM drive, to play interactive CD-ROMs in the event that supplemental data is supplied locally on disk (col. 8, l. 52-55). As such, the examiner maintains that Shoff et al. teaches a set-top system including a storage including subsidiary data, as currently claimed.

Further regarding claims **1**, **13**, **32**, and **40**, the applicant argues that the cited art nowhere teaches or suggests that the subsidiary data be received from a primary (or first) external source prior to receipt of primary content data. The examiner respectfully disagrees. As noted above, Shoff et al. discloses that interactive content can be supplied locally on a storage medium, such as a CD-ROM (col. 7, l. 61-67 & col. 8, l. 52-55). A content developer creates the interactive CD-ROM (col. 7, l. 63-65). Shoff et al. further discloses that the content developer is the same provider that distributes the video content program (col. 3, l. 10-12). As such, the examiner maintains that Shoff et al. teaches that the subsidiary data be received from a primary (or first) external source prior to receipt of primary content data, as currently claimed.

Claim Objections

1. Claims **1**, **13**, and **32** are objected to because of the following informalities:

Referring to claims 1, 13, and 32, the examiner notes that the phrase “the identifier included in the primary content data” lacks antecedent basis. The examiner notes that the claims previously state that each portion includes “... an identifier that indicates the primary content data associated with the subsidiary data;” however, the examiner fails to find a previous recitation of an identifier *included* in the primary content data.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7, 9, 10, 12-18, 20-23, 25-27, 29-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Shoff et al.

Referring to claim 1, Shoff et al. discloses a method/medium/entertainment system comprising:

- receiving primary content data at a set-top system 26 (Fig. 2) from a primary external source 42 (col. 4, l. 62-67; col. 5, l. 1-5; & Fig. 2);
- generating an output signal including the primary content data for display on a display coupled to the set-top system (col. 4, l. 22-34 & Fig. 2);

- accessing a storage of the set-top system including subsidiary data independent of and complementary to the primary content data, the storage having a plurality of portions each including a piece of the subsidiary data and an identifier that indicates the primary content data associated with the subsidiary data, using the identifier included in the primary content data to obtain the piece of the subsidiary data associated with the primary content data (the examiner notes that supplemental content is displayed according to a display layout that is dynamically changed in synch with the program according to timing information or frame count)(col. 7, l. 61-67; col. 8, l. 1-3; & col. 10, l. 7-17, 34-43, 50-58);
- generating the output signal including the associated subsidiary data for display on a display (col. 9, l. 27-40 & Fig. 8c).

Referring to claims **2**, **14**, and **25**, Shoff et al. discloses the method/medium/system of claims 1, 13, and 40, respectively, further comprising:

- receiving the subsidiary data corresponding to a program of the primary content data from the primary external source prior to beginning receipt of the program (the examiner notes that it is inherent that the user receive the interactive CD-ROM from the content developer prior to receipt of the program)(col. 3, l. 10-13 & col. 7, l. 61-67); and
- storing the subsidiary data corresponding to the program locally in the storage (col. 8, l. 52-55).

Referring to claims **3**, **15**, and **26**, Shoff et al. discloses the method/medium/system of claims 2, 14, and 40, respectively, wherein obtaining subsidiary data comprises obtaining the subsidiary data from a local nonvolatile storage medium of the set-top system (col. 7, l. 61-67 & col. 8, l. 52-55).

Referring to claims **4**, **16**, and **27**, Shoff et al. discloses the method/medium/system of claims 1, 13, and 40, respectively, further comprising determining an elapsed time of a program of the primary content data; identifying a portion of the subsidiary data from the plurality of portions which corresponds to the program; identifying a piece of the portion of the subsidiary data which corresponds to the elapsed time of the program; and causing the piece to be displayed concurrently with the primary content data (col. 9, l. 66 & col. 10, l. 1-17, 34-58).

Referring to claims **5** and **17**, Shoff et al. discloses the method/medium of claims 4 and 16, respectively, wherein identifying a portion of the subsidiary data comprises accessing the storage (col. 7, l. 65-67).

Referring to claim **6**, Shoff et al. discloses the method of claim 1, wherein the primary content data comprises data of at least one of a television broadcast, a digital satellite broadcast, an Internet broadcast, and an audio-only broadcast (col. 4, l. 62-67 & col. 5, l. 1-5).

Referring to claims **7** and **18**, Shoff et al. discloses the method/medium of claims 1 and 13, respectively, further comprising determining the identity of the primary content data currently displayed via reading an identifier associated with the primary content data (col. 5, l. 61-67; col. 6, l. 1-28; col. 8, l. 62-67; & col. 9, l. 1-5).

Referring to claims **9** and **20**, Shoff et al. discloses the method/medium of claims 1 and 13, respectively, further comprising retrieving the subsidiary data from a remote server (col. 5, l. 12-23 & col. 7, l. 26-50, 61-67).

Referring to claims **10**, **21**, and **30**, Shoff et al. discloses the method/medium/system of claims 1, 13, and 40, respectively, wherein the subsidiary data comprises at least one of reference information regarding a program of the primary content data, biographical information regarding actors, guests or participants of a program of the primary content data (col. 5, l. 16-23).

Referring to claims **12** and **23**, Shoff et al. discloses the method/medium of claims 1 and 13, respectively, wherein the output signal causes the subsidiary data to be displayed synchronous to the primary content data (col. 10, l. 8-17).

Referring to claim **13**, Shoff et al. discloses a machine-readable medium having stored thereon instructions which, when executed by a set-top system, cause the set-top system to perform operations comprising:

- receiving primary content data at the set-top system 24 (Fig. 2) from a primary external source 42 (col. 4, l. 62-67; col. 5, l. 1-5; & Fig. 2)
- generating a display signal to cause a display coupled to the set-top system to display the primary content data (col. 4, l. 22-34);
- accessing a storage database of the set-top system including subsidiary data received from the primary external source prior to receipt of the primary external source prior to receipt of the primary content data, the storage database

having a plurality of portions each including a piece of the subsidiary data and an identifier that indicates the primary content data associated with the subsidiary data, using the identifier included in the primary content data to obtain the piece of the subsidiary data associated with the primary content data (the examiner notes that supplemental content is displayed according to a display layout that is dynamically changed in synch with the program according to timing information or frame count)(col. 3, l. 10-13; col. 7, l. 61-67; col. 8, l. 1-3; & col. 10, l. 7-17, 34-43, 50-58); and

- generating the display signal to cause the display to display the associated subsidiary data (col. 9, l. 27-40 & Fig. 8c).

Referring to claim **22**, Shoff et al. discloses the machine-readable medium of claim 18, wherein the instructions for determining the identity of the primary content data are performed in response to a change in the primary content data currently displayed (col. 8, l. 62-67 & col. 9, l. 1-8).

Referring to claim **29**, Shoff et al. discloses the set-top system of claim 40, wherein the storage database includes an identification of a remote server from which subsidiary data may be retrieved and wherein the second controller is operative to request retrieval of the subsidiary data from the identified remote server (col. 5, l. 12-23).

Referring to claim **31**, Shoff et al. discloses the set-top system of claim 40, wherein the second controller is operative to determine the identity of the primary content data in response to a change in the primary content data currently displayed (col. 8, l. 62-67; col. 9, l. 1-8).

Referring to claim **32**, Shoff et al. discloses an entertainment system 62 90 (Figs. 4, 5) comprising:

- a data receiver 98 (Fig. 5) to receive primary content data from a first external source (col. 8, l. 10-14);
- a storage database to store subsidiary data independent of and complementary to the primary content data received from the first external source prior to receipt of the primary content data, the storage database including a plurality of portions each including an identifier that indicates associated primary content data and a piece of the subsidiary data (the examiner notes that supplemental content is displayed according to a display layout that is dynamically changed in synch with the program according to timing information or frame count)(col. 3, l. 10-13; col. 7, l. 61-67; col. 8, l. 1-3; & col. 10, l. 7-17, 34-43, 50-58); and
- a controller to determine whether subsidiary data corresponding to the currently displayed primary content data exists in the storage database using the identifier included in the primary content data (col. 9, l. 20-29) and to obtain the subsidiary data for display synchronous to the primary content data (col. 9, l. 20-29 & col. 10, l. 1-17, 34-43).

Referring to claim **33**, Shoff et al. discloses the entertainment system of claim 32, further comprising a second controller to combine the primary content data with the subsidiary data and forward the combined data to a display (computing unit 62 uses the received digital data in order

Art Unit: 2623

to synchronize the supplemental data with the primary program so computing unit 62 must have video/audio logic)(col. 9, l. 66-67 & col. 10, l. 1-17, 34-58).

Referring to claim 34, Shoff et al. discloses the entertainment system of claim 32, wherein the controller is to provide received subsidiary data to the storage database (col. 8, l. 4-34, 52-55 & Fig. 5).

Referring to claim 35, Shoff et al. discloses the entertainment system of claim 32, wherein the controller is to allow a user to interact with the storage database (col. 8, l. 4-34, 52-55 & Fig. 5).

Referring to claim 36, Shoff et al. discloses the entertainment system of claim 32, wherein the controller is to allow a user to access a programming guide (col. 8, l. 38-44).

Referring to claim 37, Shoff et al. discloses the entertainment system of claim 32, wherein the controller is to allow a user to toggle enablement of the subsidiary data (col. 8, l. 4-34, 52-55; col. 9, l. 42-59; col. 11, l. 45-47; & Fig. 5).

Referring to claim 38, Shoff et al. discloses the method of claim 7, further comprising obtaining the associated subsidiary data based on a second identifier (supplemental content target 58) associated with the primary content data (the examiner notes that the supplemental content is associated with the program in the EPG)(Fig. 3).

Referring to claim 39, Shoff et al. discloses the method of claim 1, further comprising obtaining the associated subsidiary data based on a time period stored in the portion of the

storage, the time period identifying a given time in the primary content data (col. 7, l. 61-67; col. 8, l. 1-3; & col. 10, l. 7-17).

Referring to claim **40**, Shoff et al. discloses a set-top system comprising:

- a first data receiver 98 to receive primary content data from a primary external source (col. 4, l. 62-67; col. 5, l. 1-5; & Fig. 5);
- a storage device to store subsidiary data independent of and complementary to the primary content data (col. 8, l. 38-41, 52-55);
- a first controller 92 to receive the primary content data from the first data receiver and associated subsidiary data from a second controller and provide the primary content data and the associated subsidiary data to a display (col. 8, l. 62-67; col. 9, l. 1-40; col. 10, l. 1-17, 34-60; & Fig. 8a-8c); and
- the second controller coupled between the first controller and the storage device to obtain and forward the associated subsidiary data to the first controller, wherein the second controller is to obtain the associated subsidiary data from the storage device based on an identifier included with the primary content data (col. 7, l. 65-66 & col. 9, l. 20-26).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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